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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,409	10/30/2001	Kenneth J. Wilson	1521-251US	8743
570	7590	02/24/2005	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103-7013			TAYLOR, NICHOLAS R	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,409

Applicant(s)

WILSON, KENNETH J.

Examiner

Nicholas R Taylor

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/30/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 have been examined and are rejected.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 15-17, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaw et al. (US Patent 6,282,565.)

4. As per claim 15, Shaw teaches a method for interacting with a client computer and setting outcome criteria and outcome instructions in an e-mail server (Shaw, figure 1, item 100) connected to the client computer, the method comprising:

logging in to the e-mail server with a user-name; (Shaw, column 2, lines 2-3)

receiving a configuration page from the e-mail server; entering the outcome criteria into the configuration page; entering the outcome instructions into the configuration page; and submitting the configuration page to the e-mail server (Shaw, figure 2A, column 4, line 29 to column 6, line 10.)

5. As per claim 16, Shaw teaches the system further wherein the outcome criteria comprises a "from" address (Shaw, column 3, lines 53-62, wherein the sending user comprises the "from" address, also column 5, lines 1-21.)

6. As per claim 17, Shaw teaches the system further wherein the outcome criteria includes a text string (Shaw, column 4, lines 28-38.)

7. As per claim 19, Shaw teaches the system further wherein the outcome instructions include instructions for activating an annunciator (Shaw, column 5, line 45 to column 6, line 10.)

8. As per claim 20, Shaw teaches the system further wherein the outcome instructions include the address of an addressee for receiving the e-mail message (Shaw, column 5, lines 1-21.)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4 and 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (US Patent 6,282,565) and Hickman et al. (US Patent 5,956,486.)

11. As per claims 1 and 10, Shaw teaches a system comprising an e-mail server and a plurality of computers connected to the server, a method for transmitting an e-mail message received by the server to one of the plurality of computers (Shaw, figure 1), the method comprising the steps of:

receiving the e-mail message in the server; (Shaw, column 2, line 64 to column 3, line 5)

storing the e-mail message in a mailbox corresponding to a user-name; (Shaw, column 10, lines 40-64)

determining if an e-mail client corresponding to the user-name has formed a connection between the one of the plurality of computers and the server; transmitting the e-mail message to the one of the computers if the connection has been formed; and (Shaw, column 10, lines 40-64)

deleting the e-mail message from the mailbox after the e-mail message has been transmitted (Shaw, column 10, lines 40-64, wherein after transfer the message is removed from the system.)

Shaw fails to teach specifically incrementing and decrementing a counter representative of the number of email messages stored in a mailbox. Hickman teaches a method for monitoring email systems including a counter tracking the total number of emails in a mailbox (Hickman, column 10, lines 20-52.) It would have been obvious to

one of ordinary skill in the art, at the time the invention was made, to have combined Shaw and Hickman to provide the mailbox counter of Hickman in the system of Shaw, because doing so would enable a way to effectively monitor email systems (Hickman, column 2, lines 15-20.)

12. As per claims 2 and 11, Shaw-Hickman teaches the system further including the step of scanning the e-mail message stored in the mailbox to determine if a text string within the e-mail message meets a predetermined outcome criteria (Shaw, column 3, lines 53-62.)

13. As per claim 3, Shaw-Hickman teaches the system further wherein the text string comprises a "from" address (Shaw, column 3, lines 53-62, wherein the sending user comprises the "from" address, also column 5, lines 1-21.)

14. As per claim 4, Shaw-Hickman teaches the system further wherein the text string includes a "from" address and a text string other than the "from" address (Shaw, column 5, lines 1-21.)

15. As per claims 6 and 12, Shaw-Hickman teaches the system further including the step of causing a predetermined outcome if the text string meets the outcome criteria (Shaw, column 4, lines 28-38.)

16. As per claims 7 and 13, Shaw-Hickman teaches the system further wherein the outcome comprises activating an annunciator (Shaw, column 5, line 45 to column 6, line 10.)

17. As per claims 8 and 14, Shaw-Hickman teaches the system further wherein the outcome comprises forwarding the message to an addressee (Shaw, column 5, line 45 to column 6, line 10.)

18. As per claim 9, Shaw-Hickman teaches the system further including the step of the server receiving a description of the outcome criteria and the outcome from the one of the plurality of computers (Shaw, column 4, lines 60-67.)

19. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (US Patent 6,282,565) and Hickman et al. (US Patent 5,956,486), further in view of Takahashi et al. (US Patent 6,442,589.)

20. As per claim 5, Shaw-Hickman teaches the system further wherein the text string includes a "from" address (Shaw, column 3, lines 53-62, wherein the sending user comprises the "from" address, also column 5, lines 1-21.) However, Shaw-Hickman fails to teach checking for an "urgent" flag.

Takahashi teaches an email filtering and forwarding system (Takahashi, column 4, lines 29-31) that filters email based on "urgent" priority criteria (Takahashi, column 6, lines 29-42.)

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Shaw-Hickman and Takahashi to provide the priority filtering of Takahashi in the system of Shaw-Hickman, because doing so would enable advantageous sorting and forwarding of high priority e-mail messages (Takahashi, column 4, lines 29-31.)

21. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (US Patent 6,282,565) and Takahashi et al. (US Patent 6,442,589.)

22. As per claim 18, Shaw teaches the above. However, Shaw fails to teach wherein the outcome criteria include an "urgent" flag. Takahashi teaches an email filtering and forwarding system (Takahashi, column 4, lines 29-31) that filters email based on "urgent" priority criteria (Takahashi, column 6, lines 29-42.)

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Shaw and Takahashi to provide the priority filtering of Takahashi in the system of Shaw, because doing so would enable advantageous sorting and forwarding of high priority e-mail messages (Takahashi, column 4, lines 29-31.)

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes US PGPub 2002/0087643, US Patent 5,917,489, and US Patent 5,283,856.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas Taylor
Examiner
Art Unit 2141


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER